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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,743	04/15/2004	David Edwin Thurston	065435-9035	7033

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EXAMINER

COPPINS, JANET L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/824,743

**Applicant(s)**

THURSTON ET AL.

**Examiner**

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-46 is/are pending in the application.
- 4a) Of the above claim(s) 26-35 and 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-40 is/are rejected.
- 7) ☒ Claim(s) 36-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/763,813.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

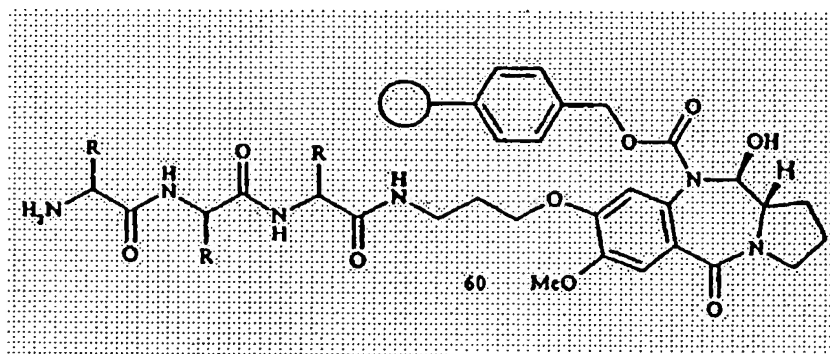
Claims 26-46 are pending in the instant application.

### *Information Disclosure Statement*

1. Applicants' Information Disclosure Statements (IDS), filed March 10, 2005, and April 26, 2005, have been considered by the Examiner. Please refer to Applicants' copies of the PTO-1449 forms submitted herewith.

### *Election/Restrictions*

2. Applicant's election of Group II, claims 36-40, without traverse, in the reply filed on May 8, 2006, is acknowledged. Pursuant to the telephonic interview on May 1, 2006, Applicants further elect compounds according to formula 60 of Figure 12 for examination:



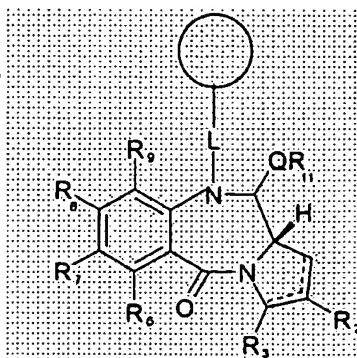
Accordingly, claims 26-35 and 41-46 are currently withdrawn from further consideration by the Examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations.

### *Status of the Claims*

3. The scope of the invention of the elected subject matter is as follows (please refer to paragraph "3" of the Restriction Requirement):

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Compounds of formula (I),



as defined in claim 36, wherein:

$R_2$ ,  $R_3$ ,  $R_6$ , and  $R_9$  are hydrogen;  $R_7$  is methoxy,  $R_8$  is  $H-(T)_n-X'-Y-A-$  (wherein  $A$  is  $O$ ,  $X'$  is  $NH$ , and  $Y$ ,  $T$  and  $n$  are as defined);  $Q$  is  $O$  and  $R_{11}$  is hydrogen; there is no double bond between  $C1$  and  $C2$  or  $C2$  and  $C3$ ; and “-L-O-” is as defined.

As a result of the election and the corresponding scope of the invention as identified supra, the remaining subject matter of claims 36-40 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions (i.e. compounds within claims 26-40 that are excluded from the scope of the invention defined above), please refer to pages 3-4 of the Restriction Requirement which explain the practice set forth for defining the scope of an independent invention. The **withdrawn** compounds contain varying functional groups for the  $R_2$ - $R_9$  and  $R_{11}$  moieties that are chemically recognized to differ in structure and function from the elected invention set, as defined above (withdrawn compounds are those wherein all of  $R_2$ ,  $R_3$ ,  $R_6$ , and  $R_9$  are NOT hydrogen;  $R_7$  is other than methoxy; and the  $H-(T)_n-X'-Y-A-$  moiety is found other than at the  $R_8$  position or wherein  $A$  is not  $O$ ,  $X'$  is not  $NH$ ;  $Q$  is not  $O$  or  $R_{11}$  is  $R$ ). Therefore the subject matter that has been withdrawn from consideration as being non-elected subject matter, differs materially in structure and composition and has been

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restricted properly, and a reference that anticipates the elected subject matter would not render obvious the withdrawn subject matter, and the fields of search would not be coextensive.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36-40 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language “A collection of compounds” renders the claims indefinite because it is unclear what is encompassed by the claim language. The term “collection” implies more than one compound, or more than one set of compounds, such that it is not clear what is included or excluded from the claim. The Examiner recommends the language, “ A compound according to formula (I):” since this language includes any compound encompassed by the structure of formula (I).

***Claim Objections***

6. Claims 26-40 objected to as containing non-elected subject matter.

***Conclusion***

7. In conclusion, claims 26-46 are pending, however, claims 26-35 and 41-46 are withdrawn from consideration. Claims 36-40 are currently rejected.

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
July 17, 2006

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Joseph K. McKane", written over a horizontal line.

Joseph K. McKane  
SPE, Art Unit 1626